



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/425,739	10/22/1999	CHARLES A. PEYSER	07710.0003-0	9954

32042 7590 09/23/2003

PATTON BOGGS LLP  
8484 WESTPARK DRIVE  
SUITE 900  
MCLEAN, VA 22102

EXAMINER

SMITH, JEFFREY A

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 09/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/425,739

Applicant(s)

PEYSER ET AL.

Examiner

Jeffrey A. Smith

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 3625

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Mashinsky (U.S. Patent No. 6,226,365 B1).

Mashinsky discloses a telecommunication providing system and method.

The system comprises a server having access to a memory containing a set of responses to purchase request for telecommunication services (col. 9, lines 22-33); and a client (col. 22, lines 45-47), connected to the server (col. 22, lines 32-35), for inputting a purchase request (col. 11, lines 31-55), accessing the stored set of responses (col. 22, lines 48-67),

Art Unit: 3625

and providing an acceptance to the responses (col. 23, lines 7-14).

The method is disclosed for distributing telecommunication services (col. 2, lines 32-45).

### ***Response to Arguments***

Applicant's arguments filed 09 July 2003 have been fully considered but they are not persuasive.

Applicant's remarks that "Mashinsky neither teaches nor suggests the presently claimed methods in which (1) the buyer makes a purchase request.....(2) the buyer receives one or more responses from service providers....(3) the buyer has the option of accepting at least one of the responses....".

The Examiner notes that such remarks are not commensurate with the scope of method claims 1-7, and 9. None of these claims recites any step which is performed by any particular party. A "buyer" is never recited. The only recitations to various parties are to "service providers" (claim 1, line 4, for example) and "a requestor" (claim 1, last line, for example). These parties, however, are not recited as actually performing an active step of the methods.

Art Unit: 3625

Applicant remarks that Mashinsky does not "teach or suggest the claimed systems in which a session is established for a client to input a purchase request, access stored responses, and accept a response during the session".

The Examiner notes that claim 8 is directed to a system and recites, *inter alia*, a client, electronically connectable to the server, to establish a session for (i) inputting a purchase request...(ii) accessing the stored set of responses...(iii) providing an acceptance to the response during the session" (claim 8, last indent). The recitations of subsections (i)-(iii) are considered functional recitations which do not move to structurally distinguish the system of the instant claim from the structure disclosed by Mashinsky '365 B1. Structurally, the Examiner has identified a server having access to a memory (col. 9, lines 22-33), and a client (col. 22, lines 45-47), electronically connectable to the server (col. 22, lines 32-35).

Applicant remarks that "The present claims are directed to a completely different invention by providing methods and systems for purchasing telecommunication services".

The Examiner notes that Mashinsky '365 B1 is not limited to routing calls. Mashinsky '365 B1 also discloses methods and systems for purchasing telecommunication services (see col. 9,

Art Unit: 3625

lines 22-33; col. 11, lines 31-55; col. 22, lines 48-67; and col.23, lines 7-14).

Applicant remarks that "the relied upon portions of the reference do not teach or suggest the present claims".

The Examiner has cited certain passages in order to best exemplify the manner in which the claim recitations "read-on" Mashinsky '365 B1. These passages are not intended to be read in a vacuum. It is the entirety of the Mashinsky '365 B1 disclosure which is relied upon for anticipation of the claims, not simply certain passages alone.

#### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated

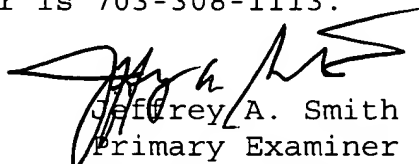
Art Unit: 3625

from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Smith whose telephone number is 703-308-3588. The examiner can normally be reached on M-F 6:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

  
Jeffrey A. Smith  
Primary Examiner  
Art Unit 3625

jas